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PATENT APPLICATION



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

EDDIE F. RAY, III ET AL.

Appln. No.: 10/766,504

Filed: January 27, 2004

For: BONE GRAFTS

)  
: Examiner: Julianna Nancy Harvey  
)  
: Art Unit: 4153  
)  
: Confirmation No.: 3501  
)  
: March 13, 2008

The Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT  
AND PETITION FOR EXTENSION OF TIME

Sir:

Applicants petition to extend the time for response to the Office Action dated December 13, 2007, to March 13, 2008. Please charge the amount of \$460.00 in payment of the extension fee, and charge any additional fee and credit any overpayment, to our Deposit Account 06-1205.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

March 13, 2008  
(Date of Deposit)

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Ronald A. Clayton  
(Name of Attorney for Applicant)

Signature

March 13, 2008  
Date of Signature

In response to that Office Action, Applicants offer the following remarks.

In the Office Action, the Examiner required restriction of further prosecution to claims of one of the following groups:

- Group I: Claims 1-15, 19-46, and 50-66, drawn to a bone allograft;
- Group II: Claims 16, 18, 47, and 49, drawn to a method for restoring vertical support; and
- Group III: Claims 17, 18, 48, and 49, drawn to a method of making an allograft.

The Examiner further imposed an election-of-species requirement, requiring Applicants to elect a single species from those listed below, if Applicants were to choose

Group I:

- A. Figure 1;
- B. Figures 3-4;
- C. Figures 5-6;
- D. Figures 7-8;
- E. Figure 11;
- F. Figure 12;
- G. Figure 13;
- H. Figures 14-17;
- I. Figure 18;
- J. Figures 19-20;
- K. Figure 21;
- L. Figure 22;
- M. Figure 23;
- N. Figures 24-25;
- O. Figure 26;
- P. Figure 27;
- Q. Figure 28;
- R. Figure 29;
- S. Figures 30-32; and
- T. Figures 33-36.

Applicants hereby provisionally elect to prosecute Group I, comprising Claims 1 to 15, 19 to 46 and 50 to 66 directed to a bone allograft. Applicants further elect Specie F (Figure 12), on which at least Claims 1, 2, 3, 4, 6, 7, 12, 13, 15, 20, 23, 26, 28, 31, 32, 33, 34, 35, 37, 38, 43, 44, 51, 54, 57, 65, and 66 are readable, for initial prosecution on the merits. The restriction requirement is, however, respectfully traversed for the following reasons:

All claims in the subject case are presented for the purpose of provoking an interference with U.S. Patent No. 6,511,509 (Ford, et al.). These claims were copied either identically or in modified form from Claims 1 to 10, 13, 16, 17, 20, and 22 to 25 of the Ford Patent.

Claims 1 to 21 of the Ford Patent are directed to a bone allograft and correspond to Group I, Claims 1 to 15, 19 to 46, and 50 to 66 of the subject application; Claims 23 and 25 of the Ford Patent are directed to a method of restoring vertical support and correspond to Group II, claims 16, 18, 47 and 49 of the subject application; and Claims 24 and 25 of the Ford Patent are directed to a method of making a bone allograft and correspond to Group III, Claims 17, 18, 48 and 49 of the subject application. Thus, the Ford Patent issued with claims in the same three groups to which restriction is required in the subject case. Moreover, when filed U.S. Patent Application No. 09/073,897, which issued as the Ford Patent presented claims in each of these three groups, yet at no point in prosecution was a restriction requirement made by the Patent and Trademark Office in that Ford application. Therefore, it is respectfully submitted that it is inappropriate and unfair to restrict prosecution in this case to three groups of claims that were consistently examined together and ultimately issued together in the Ford Patent.

It is also submitted that dividing prosecution in the subject application to separate examination of three groups of claims would be unnecessarily inefficient and cumbersome for the Patent and Trademark Office. Again, the subject application was filed in order to provoke an interference with the Ford Patent. If the restriction requirement is made final, then the subject application will be divided into three applications, in each of which the applicants will request an interference; three applications in which the Patent and Trademark Office will be required to consider whether to declare an interference; and if in each case an interference is declared, three interferences all against the same patent to Ford. Such a result and consequent procedures would be undesirable to both the Examiner and the Board of Patent Appeals and Interferences.


Accordingly, for the reasons set forth above, Applicants respectfully request reconsideration and withdrawal of the restriction requirement, and examination of all claims in the subject application.

Applicants do not traverse the election of species requirement. However, applicants submit that at least Claim 1 is generic to at least species B (Figs. 3, 4), D (Figs. 7, 8), F (Fig. 12), G (Fig. 13), L (Fig. 22), M (Fig. 23), S (Figs. 30-32), and T (Figs. 33-36).

An early and favorable examination of all the claims on the merits is respectfully requested.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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